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09/944,501	08/30/2001	Masashi Kon	09792909-5130	2401
26263 7590 03/18/2009 SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080				
EXAMINER SHERR, CRISTINA O				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/944,501

Applicant(s)

KON ET AL.

Examiner

CRISTINA OWEN SHERR

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 12-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to Applicant's Amendment filed January 8, 2009. Claims 1- 27 are currently pending in this case. Claims 1-11 are under examination.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 24, 2008 has been entered.

#### ***Election/Restrictions***

3. Applicant's election without traverse of species I in the reply filed on January 8, 2009 is acknowledged. Accordingly, claims 1-11 are currently under examination.

#### ***Response to Arguments***

4. Applicant's arguments filed August 14, 2008 have been fully considered but they are not persuasive.

5. Applicant argues, regarding claim 1, that nothing in the cited reference discloses, teaches or suggests an apparatus that "makes a determination of whether a certificate has been received and stored locally, prior to requesting the certificate from a remote location."

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6. Examiner respectfully disagrees and directs attention to Bianco, wherein "init object 406 knows which receiver object needs to be created by the client . . . to perform the specific task required." (col 16 ln 7-9). It is clear that in order to know which object or certificate needs created and stored, you must first determine whether it is there at all.

***Remarks***

7. Note that claim 1 recites, inter alia, "a person identification certificate authority as a person identification certificate issuing entity". Although the drawings make clear that this refers to a server, rather than a person or a group of persons, the claim itself is unclear in this respect.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-11 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Bianco ET al (US 6,256,737).

10. Regarding claim 1 –

11. Bianco discloses a person authentication application data processing system for performing a person authentication process based on a verification process between a template extracted from a person identification certificate in which the template (104, col 3 ln 1-5, "compared measurements of unique

personal characteristics") which is person identification data of an individual user who uses an information processing apparatus and user input sampling information, said person authentication application data processing system comprising:

an information processing apparatus as a person authentication execution entity (e.g. col 3 ln 7-17, "administration station"); and

a person identification certificate authority as a person identification certificate issuing entity (e.g. col 3 ln 33-40, "certificate authority system", 104),

wherein said information processing apparatus performs a process of retrieving a person identification certificate used for a person authentication process based on user input information, and, when the information processing apparatus determines that the person identification certificate has not been received from the person identification certificate authority and stored locally in a local storage device of the information processing apparatus, outputs a request for issuing a person identification certificate to the person identification certificate authority when a person identification certificate corresponding to the user input information cannot be extracted (e.g. col 16 ln 5-20, "'switchboard object receives the request, via comm. object, and creates receiver object')

said person identification certificate authority creates a person identification certificate in which an encrypted template which can be decrypted in said information processing apparatus and performs an issuing process for the information processing apparatus (e.g. col 54 ln 10-28, " digital certificate from a certificate authority"), and

said information processing apparatus performs a process for storing the person identification certificate issued from said person identification certificate authority in the storage means of the information processing apparatus (e.g. col 54 In 10-28, "encrypted digital certificate containing . . . identification information").

12. Bianco does not use the same steps in the same order as the instant application. Mere re-ordering of steps, however, would be obvious to one of ordinary skill in the art and thus does not confer patentability. Note also that Bianco, at, e.g., : "FIG. 7 includes biometric server 104 (FIG. 1), computer 208 (or alternatively remote/web computer 210, both from FIG. 2), authentication interface 704, authentication interface 706, authentication object 708, database object 710, policy object 712, comm object 716, comm object 718, authentication object 720 and biometric device object 722. Here, biometric server 104 is performing as the server and computer 208 is performing as the client." (col 22, In 41-49).

13. Thus, Bianco does allow for either remote or local template checking.

14. Regarding claim 2 –

15. Bianco discloses a person authentication application data processing system according to Claim 1, wherein, in the process for storing the newly obtained person identification certificate in the storage means, when said newly obtained person identification certificate is a person identification certificate corresponding to the same user for an existing public key certificate which has already been stored in said information processing apparatus, said information

processing apparatus performs a process for creating pair information of identifiers of each certificate and stores the pair information in the storage means (e.g. col 54 ln 20-30).

16. Regarding claim 3 –

17. Bianco discloses a person authentication application data processing system according to Claim 1, further comprising a certificate authority as a public key certificate issuing entity, wherein, said information processing apparatus performs a process for retrieving a public key certificate used during data communication with an external apparatus with stored data of the storage means of the information processing apparatus being used as the retrieval target on the basis of the user input information, creates a pair of a public key and a secret key when the applicable public key certificate cannot be extracted, transmits the created public key to the certificate authority which is the issuing entity of the public key certificate and makes a request for issuing a person identification certificate, said certificate authority performs a process for issuing a public key certificate corresponding to an individual user or a public key certificate corresponding to said information processing apparatus, and said information processing apparatus performs a process for storing the public key certificate issued from said certificate authority in the storage means of the information processing apparatus (e.g. col 54 ln 20-30).

18. Regarding claim 4 –

19. Bianco discloses a person authentication application data processing system according to Claim 3, wherein, in the process for storing the newly

obtained person identification certificate in the storage means, when said newly obtained person identification certificate is a person identification certificate corresponding to the same user for an existing public key certificate which has already been stored in said information processing apparatus, said information processing apparatus performs a process for creating pair information of identifiers of each certificate, stores the pair information in the storage means, and registers together a process identifier which identifies a process such as services to be used (e.g. col 55 ln 45-60).

20. Regarding claim 6 –

21. Bianco discloses a person authentication application data processing system according to Claim 1, further comprising a service distribution construction in which various services such as content distribution can be received from a service provider under the control of a service registration server on the condition of user registration for the service registration server, wherein said information processing apparatus performs a person authentication process based on a verification process between the template extracted from the person identification certificate in which the template which is person identification data of an individual user who uses the information processing apparatus is process for creating pair information of identifiers of each certificate and stores the pair information in the storage means (e.g. col 2 ln 50-60).

22. Regarding claim 5 –



23. Bianco discloses a person authentication application data processing system according to Claim 3, wherein, in the process for storing the newly obtained person identification certificate in the storage means, when said newly obtained person identification certificate is a person identification certificate corresponding to the same user for an existing public key certificate which has already been stored in said information processing stored and user input sampling information and performs user registration for said service registration server on the condition that person authentication is established (e.g. col 55 In 45-60).

24. Regarding claim 7 –

25. Bianco discloses a person authentication application data processing system according to Claim 1, further comprising a service distribution construction in which various services such as content distribution can be received from a service provider under the control of the service registration server on the condition of user registration for the service registration server, wherein said information processing apparatus performs mutual authentication with said service provider by using a public key certificate corresponding to an individual user or a public key certificate corresponding to said information processing apparatus in a process for receiving service distribution from said service provider, and said service provider provides services for said information processing apparatus on the condition that it is confirmed that the public key certificate used for said mutual authentication corresponds to an authorized user

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or device registered in said service registration server and said mutual authentication is established (e.g. abstract, col 3 ln 33-40).

26. Regarding claim 8 –

27. Bianco discloses a person authentication application data processing system according to Claim 1, wherein data communication between said information processing apparatus as a person authentication execution entity and the person identification certificate authority as a person identification certificate issuing entity is performed on the condition that the mutual authentication process is established (e.g. abstract, col 2 ln 53 – col 3 ln 5).

28. Regarding claim 9 –

29. Bianco discloses a person authentication application data processing system according to Claim 1, wherein, for data communication between said information processing apparatus as a person authentication execution entity and the person identification certificate authority as a person identification certificate issuing entity, a data transmission part performs a process for creating an electronic signature for transmission data, and a receiving part performs a process for verifying the electronic signature (e.g. col 55 ln 47-57).

30. Regarding claim 10 –

31. Bianco discloses a person authentication application data processing system according to Claim 1, wherein an encryption key used to encrypt the template stored in the person identification certificate issued from said person identification certificate authority is a public key which is set for said information processing apparatus or an individual user (e.g. col 55 ln 37-45).

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32. Regarding claim 11 –

33. Bianco discloses a person authentication application data processing system according to Claim 1, wherein said template is biometric information of a person such as fingerprint information, retina pattern information, iris pattern information, voice print information, and handwriting information, or a non-biometric information such as a seal, a passport, a driver's license, and a card, or any combination of two or more of the biometric information and the non-biometric information, or a combination of any of the information and a password (e.g. abstract).

34. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

36. Matchett et al (US 5,229,764) discloses a continuous biometric authentication matrix.

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37. Musgrave et al (US 6,505,193) discloses a system and method of fast biometric database searching using digital certificates.
38. Marckini et al (US 5,907,149) disclose an identification card with delimited usage.
39. Ohtsuki et al (US 5,831,547) disclose a wireless card system.
40. Khidekel et al (US 2001/0027527) disclose a secure transaction system.
41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA OWEN SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.
42. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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43. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRISTINA OWEN SHERR  
Examiner  
Art Unit 3685

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